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Filing date: **03/20/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91196299
Party	Defendant Digitalmojo, Inc.
Correspondence Address	THOMAS W. COOK 3030 BRIDGEWAY, SUITE 425-430 SAUSALITO, CA 94965-2810 UNITED STATES thomascooklaw@pacbell.net
Submission	Motion to Amend/Amended Answer or Counterclaim
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Signature	/Thomas W. Cook/
Date	03/20/2012
Attachments	Reply to CPR's Response - Second Amended Motions for Leave to Amend Petitions.pdf ( 12 pages )(134707 bytes ) 2011 10 17 Declaration of Thomas Cook in Support of Response to Motion to Dismiss - 2373504.pdf ( 11 pages )(456237 bytes ) 2011 10 17 Declaration of Cook in Support of Response to CPR's Motion to Dismiss - 2366850.pdf ( 11 pages )(456180 bytes )

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

	)	
<b>Opposition No. 91196299 (Parent)</b>	)	
	)	
CONNECT PUBLIC RELATIONS, INC.	)	
Opposer,	)	
	)	
v.	)	<b>REPLY TO CONNECT PUBLIC</b>
	)	<b>RELATIONS' RESPONSE -</b>
DIGITALMOJO, INC., Applicant	)	<b>SECOND AMENDED MOTIONS</b>
	)	<b>FOR LEAVE TO AMEND</b>
	)	<b>PETITIONS TO CANCEL</b>
<b>Cancellation No. 92054395</b>	)	
<b>Cancellation No. 92054427</b>	)	
	)	
DIGITALMOJO, INC.,	)	
Petitioner,	)	
	)	
v.	)	
	)	
CONNECT PUBLIC RELATIONS, INC.	)	
Respondent.	)	

## **REPLY**

Consistent with Board Order of February 23, 2012, DigitalMojo, Inc. (“DigitalMojo”) files this single Reply in support of its Amended Motions for Leave to Amend Petitions to Cancel (“Amended Motions for Leave”) filed in Cancellation actions Nos. 92054395 and 92054427. This Reply is filed only in Opposition case No. 91196299, now-designated the “parent” case by such Order. The Board should grant DigitalMojo leave to amend its petitions for the reasons set forth below, notwithstanding the argument of Connect Public Relations, Inc. (“ConnectPR”).

## **ARGUMENT**

### *A. Legal Standards*

Federal Rules provide for “notice pleading.” The pleadings need not (with certain exceptions) allege facts constituting the claim for relief or defense. They need only give fair notice of the pleader’s claim or defense so that opposing parties can respond, undertake discovery and prepare for trial. See *Conley v. Gibson* (1957) 355 US 41, 47-48, 78 S.Ct. 99, 103. Thus, except when specific pleading is required, evidentiary facts need not be set forth in the complaint. See also *Leatherman v. Tarrant County Narcotics Intelligence & Coordination Unit* (1993) 507 US 163, 113 S.Ct. 1160, 1162 (“(F)ederal courts and litigants must rely on summary judgment and control of discovery to weed out unmeritorious claims...”). Further, Federal pleading requirements are extremely liberal. The rules are designed specifically to minimize disputes over pleading technicalities. See FRCP 1,8(f); and *Conley v. Gibson*, Id. Pleadings are construed liberally in favor of the pleader, and in challenging the sufficiency of a complaint, all of its material allegations are taken as true. *Jenkins v. McKeithen* (1969) 395 US 411, 421, 89 S.Ct. 184, 1849.

As to the form of pleadings under Federal Rules, “Each averment of a pleading shall be simple, concise and direct. No technical forms of pleading or motions are required.” FRCP 8(e)(1). One exception to 8(e)(1) pleading requirements, is Rule 9(b)’s requirement that fraud be pleaded “with particularity.” Generally, however, Rule 9(b)’s particularity requirement must be read in harmony with Rule 8’s requirement of a “short and plain” statement of the claim. *Michaels Bldg. Co. V. Ameritrust Co., N.A.* (6<sup>th</sup> Cir. 1988) 848 F2d 674, 679. Thus, the particularity requirement is satisfied if the pleading “identifies the circumstances constituting fraud (or mistake) so that the defendant can prepare an adequate answer from its allegations.” *Moore v. Kayport*

*Package Express, Inc.* (9<sup>th</sup> Cir. 1989) 885 F.2d 531, 540; see *Bankers Trust Co. V. Old Republic Ins. Co.* (7<sup>th</sup> Cir. 1992) 959 F.2d 677, 683-684. “Dismissal is improper unless it appears beyond doubt that the plaintiff can prove no set of facts in support of his claim which would entitle him to relief.” *Love v. United States*, 915 F.2d 1242, 1245 (9<sup>th</sup> Cir. 1989) (quoting *Gibson v. United States*, 781 F.2d 1334, 1337 (9<sup>th</sup> Cir. 1986)).

As to amendment of pleadings, Rule 15 provides the parties with flexibility in presenting their claims and defenses. It assures that cases will be heard on their merits and avoids injustices which sometimes resulted from strict adherence to earlier technical pleading requirements. *Foman v. Davis* (1962) 371 US 178, 182, 83 S.Ct. 227, 230. Rule 15 reflects the limited role assigned to federal pleading: i.e., their purpose is simply to provide the parties with fair notice of the general nature and type of the pleader’s claim or defense. As long as such notice has been provided, the pleadings should not limit the pleader’s claims or defenses. *Foman v. Davis*, Id. If a counterclaim is omitted through oversight, inadvertence, or excusable neglect, or if justice so requires, the counterclaim may be set forth by amendment with leave of court. Rule 13(f). Federal policy strongly favors determination of cases on their merits. Therefore, the role of pleadings is limited, and leave to amend the pleadings is freely given unless the opposing party makes a showing of undue prejudice, or bad faith or dilatory motive on the part of the moving party. *Foman v. Davis*, Id. There is no time limit for amendment under FRCP 15, and leave to amend is usually granted after a Rule 12 motion to dismiss, to strike, or for more definite statement is granted. Unless convinced amendment would be future, the court normally grants leave to amend and specifies the time within which the amended pleading is due.

#### B. *Undue Prejudice Alleged by ConnectPR*

In its Response, ConnectPR has alleged as fact the contrary of what DigitalMojo has alleged in its Petitions to Cancel, and ConnectPR has attempted to introduce evidence in support of its allegation. ConnectPR has therefore asked the Board to make a finding of fact based on its opposition to amendment of the Petitions, i.e. to try this portion of these cases. However, pleadings are not the time to try a case. Instead, pleadings are construed liberally in favor of the pleader, and in challenging the sufficiency of a complaint, all of its material allegations are taken as true. *Jenkins v. McKeithen*. Id. ConnectPR will have its opportunity “...on summary judgment

and control of discovery to weed out unmeritorious claims...” *Leatherman v. Tarrant County Narcotics Intelligence & Coordination Unit*. Id. Accordingly, the accuracy of the statement attributed to ConnectPR by DigitalMojo in its claims of fraud is not an issue at the pleading stage in these consolidated proceedings.

C. *ConnectPR’s Request for Dismissal Under Rule 12(b)(6)*

DigitalMojo agrees with ConnectPR’s statement of the law when considering motions to dismiss based on failure to state a claim upon which relief can be granted. Again, however, we are at the pleading stage in these cancellations. And, again, pleadings are construed liberally in favor of the pleader, and in challenging the sufficiency of a complaint, all of its material allegations are taken as true. *Jenkins v. McKeithen*. Id. DigitalMojo asserts its Amended Petitions to Cancel, which accompanied its Amended Motions for Leave, “allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought...” DigitalMojo has therefore alleged “enough factual matter ... to suggest that [a claim is plausible]” and “raise a right to relief above the speculative level,” consistent with TBMP § 503.02, and the case ConnectPR cites as authority, *Totes-Isotoner Corp. v. United States*, 594 F.3d 1346, 1354 (Fed Cir. 2010).

1. Material Misrepresentations

If accepted as true, the facts recited in the petitions to cancel establish a plausible claim that ConnectPR made a material misrepresentation to the Trademark Office. ConnectPR relies on T.M.E.P. § 1402.03 for the proposition that “...as a matter of law, there is no requirement that a trademark applicant use its mark on all of the services that may potentially fall within the broad scope of its services set forth in its trademark application prior to registration.” However, T.M.E.P. § 1402.03 (and following sections) is a section of the T.M.E.P. intended primarily to guide examining attorneys and applicants on the specificity required to make the identification of an applicant’s services “definite.” ConnectPR’s reliance on T.M.E.P. § 1402.03 is therefore misplaced. However, despite the purpose of T.M.E.P. § 1402.03, it also makes a clear statement about use of the mark on the identified services when it says: “In applications based solely on §1(a)...the applicant must have used the mark in commerce on *all* of the goods and/or services as of the application filing date.” (emphasis supplied)

ConnectPR additionally cites T.M.E.P. § 1402.03 with approval where this section recites: “As long as a broad term identifies the goods or services that are intended to be covered with reasonable certainty, it will be reasonable, from a commercial viewpoint, to consider that the mark has been used for all the related goods or services that fall within the designated group.” DigitalMojo believes this statement is directed to examining attorneys, so that they do not feel obliged to question an applicant about use of its mark on services if the broad term identifies an applicant’s services “...with reasonable certainty.” This section is not a blanket license for an applicant to identify services for which a mark has not used. Moreover, as DigitalMojo alleges in its Amended Petitions to Cancel, the services of ConnectPR in its registrations are not identified with reasonable certainty.

The controlling section of the T.M.E.P. on the question of use is T.M.E.P. § 901, which states: “In an application based on use in commerce under §1(a) of the Trademark Act, 15 U.S.C. §1051(a), the applicant must use the mark in commerce on or in connection with all the goods and services listed in the application as of the application filing date.” This section goes on to state: “Prior to registration, the applicant must actually use the mark in commerce on or in connection with all the goods or services specified in the application and file an allegation of use...” DigitalMojo has identified, throughout the Amended Petitions to Cancel, services which ConnectPR has said it has provided, but which ConnectPR has not in fact provided. These identified services are in fact not an “artfully crafted list of arbitrary sub-services,” but are services within the broad and indefinite “marketing services” language used by ConnectPR. They are also services which ConnectPR admits “...it would be impossible for ConnectPR to have use on them.” ConnectPR goes on to admit that it “...did, obtain use on other services within the broad scope of the ConnectPR Registrations but that were outside of the narrowly defined list of sub-services identified by DigitalMojo.” This of course implies that ConnectPR did not use its marks on all services within the (in ConnectPR’s words) “broadly recited services of the ConnectPR Registrations,” as required by T.M.E.P. § 901.

## 2. Abandonment

As we note above, the controlling section of the T.M.E.P. on use is T.M.E.P. § 901, which states: “In an application based on use in commerce under §1(a) of the Trademark Act, 15

U.S.C. §1051(a), the applicant must use the mark in commerce on or in connection with all the goods and services listed in the application as of the application filing date.” DigitalMojo has identified throughout the Amended Petitions to Cancel services which ConnectPR has said it has provided, but which ConnectPR has not in fact provided, including “...for some of such services” (referring to some services which fall within the services identified by ConnectPR in its registrations).

However, as we note above, DigitalMojo need not allege facts constituting the claim for relief or defense in its pleading of abandonment; it need only give fair notice of its claim or defense so that opposing parties can respond, undertake discovery and prepare for trial. *Conley v. Gibson*, Id. Pleadings are construed liberally in favor of the pleader, and in challenging the sufficiency of a complaint, all of its material allegations are taken as true. *Jenkins v. McKeithen* Id. Accordingly, DigitalMojo’s Amended Petitions to Cancel meet all pleading requirements.

### 3. Fraud Claims Alleged with Particularity

ConnectPR relies on *Asian and Western Classics B.V. v. Lynne Selkow*, 92 USPQ2d 1478,1478 (TTAB 2009) for the proposition that:

“Allegations based solely on information and belief raise only the mere possibility that such evidence may be uncovered and do not constitute pleading of fraud with particularity. Thus, to satisfy Rule 9(b), any allegations based on “information and belief” must be accompanied by a statement of facts upon which the belief is founded.” (This section of *Asian and Western Classics B.V. v. Lynne Selkow* opinion emphasized by ConnectPR).

ConnectPR specifically states what DigitalMojo should have alleged in its fraud claims, saying: “However, DigitalMojo failed to allege sufficient facts to identify who exactly made the alleged statement, where it was made, when it was made, or in what context it was made.” Whilst this list of potential factual allegations may be consistent with good newspaper reporting, DigitalMojo asserts that this kind of detailed recitation of facts is quite beyond even the heightened pleading requirements required of fraud allegations. As we note above, the particularity requirement for fraud allegations is satisfied if the pleading “identifies the circumstances constituting fraud (or mistake) so that the defendant can prepare an adequate answer from its allegations.” *Moore v. Kayport Package Express, Inc.* Id. DigitalMojo has with its fraud allegations met this requirement.

As to the requirements of *Asian and Western Classics B.V. v. Lynne Selkow, Id.*, cited by ConnectPR, DigitalMojo's allegations are not "Allegations based solely on information and belief," as ConnectPR says. Each such allegation contains factual statements. Accordingly, DigitalMojo has also met the requirements of *Asian and Western Classics B.V. v. Lynne Selkow*.

As to "...the sheer number of the fraud allegations..." said by ConnectPR to "...reveal the baselessness of the fraud allegations," ConnectPR apparently wishes the Board to gather meaning simply from the number of allegations (each of which are supported by a statement of facts as required by Fed. R. Civ. P. 9(b)). ConnectPR cites no authority for this proposition.

Finally, ConnectPR states: "DigitalMojo's fraud allegations should not be allowed because they are baseless and brought with sole purpose to harass ConnectPR and to allow DigitalMojo to conduct a costly fishing expedition." This statement likely comes closest to the heart of the matter for ConnectPR, and seems a bit odd given its opposition action, which precedes these cancellation actions. In response, we set aside ConnectPR's lack of evidence for such a statement, and that DigitalMojo's motive is not relevant at the pleading stage. We note that whether DigitalMojo's allegations are baseless, as ConnectPR asserts, is what ConnectPR must demonstrate in the course of these proceedings, once the parties have plead. DigitalMojo's Amended Motions for Leave "allege such facts as would, if proved, establish that the plaintiff is entitled to the relief sought..."

#### 4. Abandonment Claims Properly Plead

As to ConnectPR's assertion that DigitalMojo's claims of abandonment are not properly pleaded, DigitalMojo's pleadings need only give fair notice of the pleader's claim or defense so that opposing parties can respond, undertake discovery and prepare for trial. *Conley v. Gibson, Id.* DigitalMojo's abandonment claims give such fair notice.

#### 5. Rectification of Register

As to ConnectPR's assertion that prayer for relief, rectification of the register, is not properly pleaded, DigitalMojo's pleadings need only give fair notice of the pleader's claim or defense so that opposing parties can respond, undertake discovery and prepare for trial. *Conley v. Gibson, Id.* DigitalMojo's claims give such fair notice.



D. *Petitions as Compulsory Counterclaims*

On February 23, 2012, the Board issued the Order, to which ConnectPR and DigitalMojo are now responding, which Order stated:

“The petitions to cancel are the legal equivalent of a counterclaim in the opposition. See Trademark Rules 2.106(b)(2)(i) and (ii) and 2.114(b)(2)(i) and (ii); TBMP Section 313 (3d ed. 2011). Because the above-captioned proceedings involved the same parties and are intertwined, the Board, in its discretion, finds that their consolidation is warranted.”

It thus appears that the Board has addressed the last substantive issue raised by ConnectPR and, finding the Petitions were timely filed, joined all actions between ConnectPR and DigitalMojo. It also appears that a motion for leave to amend pleadings is not the place for argument under Rule 12, and DigitalMojo requests the Board disregard ConnectPR’s Response to the extent it addresses necessary counter-claims. However, as ConnectPR raises this issue again in its Response, and in the event the Board considers this issue at this stage, DigitalMojo should note the following:

A motion to dismiss for failure to state a claim<sup>1</sup> is viewed with disfavor and is “rarely granted.” *Gilligan v. Jamco Develop. Corp.* (9<sup>th</sup> Cir 1997) 108 F.3d 246, 249. On a motion to dismiss for failure to state a claim, a complaint is liberally construed in the plaintiff’s favor, generally taking as true all material facts alleged in the complaint. *Rosen v. Walters*, 719 F.2d 1422, 1424 (9<sup>th</sup> Cir 1983). Dismissal is improper unless it appears beyond doubt that the plaintiff can prove no set of facts in support of his claim which would entitle him to relief. *Love v. United States*, 915 F.2d 1242, 1245 (9<sup>th</sup> Cir. 1989)(quoting *Gibson v. United States*, 781 F.2d 1334, 1337 (9<sup>th</sup> Cir 1986)). A 12(b)(6) dismissal is proper only in extraordinary cases. *United States v. Redwood City* (9<sup>th</sup> Cir. 1981) 640 F.2d 963, 966. On a Rule 12(b)(6) motion, the court assumes that all general allegations embrace whatever specific facts might be necessary to support them. *Pelozo v. Capistrano Unified School District*, 37 F.3d 517, 521 (9<sup>th</sup> Cir. 1994). To dismiss with prejudice it must appear to a certainty that the plaintiff would not be entitled to relief under any set of facts that could be proven. *Reddy v. Litton Industries*, 912 F.2d 291, 293 (9<sup>th</sup> Cir. 1990).

ConnectPR first asserts that 37 CFR § 2.106(b)(2)(i) requires dismissal of this Petition as

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<sup>1</sup> ConnectPR does not cite within its Response rules in support of the Response, however this part of ConnectPR’s Response appears to be an argument under FRCP 12(b)(6).

a compulsory counterclaim not timely asserted in another case, i.e., the Opposition. More specifically, ConnectPR states “If the grounds for a counterclaim are known to the applicant when the answer to the opposition is filed, the counterclaim shall be pleaded with or as part of the answer. If grounds for a counterclaim are learned during the course of the opposition proceeding, the counterclaim shall be pleaded promptly after the grounds therefore are learned.”

ConnectPR acknowledges a counterclaim may properly be pleaded “promptly after the grounds therefore are learned.” DigitalMojo has, after the Opposition between these parties was filed, become aware of additional facts, in the course of discussing legal theories with opposing counsel, and in reviewing discovery responses provided by ConnectPR, and in reviewing ConnectPR’s web site and other marketing materials in light of such discovery responses. These additional facts lead DigitalMojo to the conclusion that ConnectPR is not using its marks for some of the services set forth in these registrations.<sup>2</sup> DigitalMojo has in response to ConnectPR’s initial Motions to Dismiss provided the Declaration of Thomas Cook (the “Cook Decl.”) which set forth the specific nature of these facts, so ConnectPR is aware of DigitalMojo’s reasoning in this regard. Accordingly, the Petitions should not be dismissed for failure to timely plead a compulsory counterclaim. Nevertheless, DigitalMojo files with this Reply as copy of the Cook Decl.

ConnectPR raises as its second point that DigitalMojo has alleged new grounds in the proposed Amended Petitions to Cancel. However, if a counterclaim is omitted through oversight, inadvertence, or excusable neglect, or if justice so requires, the counterclaim may be set forth by amendment with leave of court. Rule 13(f). Federal policy strongly favors determination of cases on their merits. Therefore, the role of pleadings is limited, and leave to amend the pleadings is freely given unless the opposing party makes a showing of undue prejudice, or bad faith or dilatory motive on the part of the moving party. *Foman v. Davis*, Id. There is no time limit for amendment under FRCP 15, and leave to amend is usually granted after a Rule 12 motion to dismiss, to strike, or for more definite statement is granted. Unless convinced amendment would be futile, the court normally grants leave to amend and specifies the time within which the amended pleading is due.

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<sup>2</sup> Or, in the alternative, DigitalMojo alleges that ConnectPR did not use the Mark for some part of such services.

DigitalMojo and ConnectPR are at the pleading stage in the Petitions, and DigitalMojo is with its Amended Petitions to Cancel responding to ConnectPR's assertions of improper pleading. These parties have conducted no discovery in these cases,<sup>3</sup> and ConnectPR has not changed its position in reliance on DigitalMojo's Petitions as originally filed. ConnectPR has made no showing of undue prejudice, or bad faith or dilatory motive on the part of DigitalMojo, at the time of filing the Petitions to Cancel or thereafter. Unless convinced amendment would be futile, the court normally grants leave to amend and specifies the time within which the amended pleading is due.

### **CONNECTPR'S MOTION TO DISMISS AND FURTHER AMENDMENTS**

ConnectPR has also requested, in the event the Board denies DigitalMojo's Amended Motion for Leave, that the Board consider ConnectPR's motions to dismiss previously filed in these cancellation actions, and also order DigitalMojo not to file additional motions for leave to amend its pleadings in these cancellation action.

With the exception of the compulsory counter-claim issue, which the Board has apparently already decided with its February 23, 2012 Order, DigitalMojo assumes the Board will consider its petitions as originally filed, and ConnectPR's Motions to Dismiss, if it does not grant leave to amend herewith.

In respect of additional motions for leave to amend, however, DigitalMojo opposes any order precluding its filing additional motions for leave to amend its pleadings in the cancellation proceedings. Rule 15 provides the parties with flexibility in presenting their claims and defenses. It assures that cases will be heard on their merits and avoids injustices which sometimes resulted from strict adherence to earlier technical pleading requirements. *Foman v. Davis* (1962) 371 US 178, 182, 83 S.Ct. 227, 230. Rule 15 reflects the limited role assigned to federal pleading: i.e., their purpose is simply to provide the parties with fair notice of the general nature and type of the pleader's claim or defense. As long as such notice has been provided, the pleadings should not limit the pleader's claims or defenses. *Foman v. Davis*, Id. Therefore, in the event the Board denies DigitalMojo's Amended Motion for leave, and goes on to consider and grant ConnectPR's

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<sup>3</sup> Discovery has been conducted in the now consolidated opposition, and the discovery period has closed. However, discovery issues remain between DigitalMojo and ConnectPR.

Motions to Dismiss (or any portion of them), DigitalMojo requests it be granted leave to amend its Petitions to Cancel, consistent with the Board's policy of granting such leave after a Rule 12 motion to dismiss, to strike, or for more definite statement is granted.

Date: March 19, 2012




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Attorney for DigitalMojo, Inc.

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this document is today being submitted via electronic filing utilizing  
the ESTTA system on:

Date: March 20, 2012

  
Thomas W. Cook

CERTIFICATE OF SERVICE


This is to certify that on this date, a true copy of the foregoing

**REPLY TO CONNECT PUBLIC RELATIONS' RESPONSE - SECOND AMENDED  
MOTIONS FOR LEAVE TO AMEND PETITIONS TO CANCEL**

is being served, by U.S. mail, postage prepaid, addressed to the following:

Karl R. Cannon  
CLAYTON, HOWARTH & CANNON, P.C.  
P.O. Box 1909  
Sandy, Utah 84091-1909

Date: March 20, 2012

  
Thomas W. Cook

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of  
Trademark Registration No. 2,373,504  
Trademark: CONNECT PUBLIC RELATIONS  
Registered: August 1, 2000

DIGITALMOJO, INC.,  
Petitioner,

Cancellation No. 92054427

Registration No. 2,373,504

v.

CONNECT PUBLIC RELATIONS, INC.  
Respondent.

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**DECLARATION OF THOMAS COOK, ESQ.  
IN SUPPORT OF PETITIONER'S RESPONSE  
TO DEFENDANT'S MOTION TO DISMISS - Rule 12(b)**

I, Thomas W. Cook, Esq. declare as follows:

1. I am the attorney of record for Petitioner DIGITALMOJO, INC. ("DigitalMojo").

I have personal knowledge of the facts herein stated. I am prepared to testify in a court of law regarding such facts if requested.

2. On or about January 14, 2011, and in connection with settlement discussions, I received correspondence from Karl Cannon, attorney for Respondent CONNECT PUBLIC RELATIONS, INC. ("ConnectPR), relating to its opposition to DigitalMojo's application for registration of its mark CONNECT, opposition number 91196299 (the "Opposition"). In the Opposition, ConnectPR has asserted this registration 2,373,504 as one basis for opposition, claiming likelihood of confusion between ConnectPR's service mark CONNECT PUBLIC RELATIONS (the "Mark") and DigitalMojo's mark CONNECT. From such correspondence and

communications, and from discussions and correspondence leading to and after this correspondence, I began to understand ConnectPR's position regarding the scope and extent of ConnectPR's claim regarding the legal effect of its registration. I attach a true and correct copy of the Cannon letter of January 14, 2001 to this Declaration as Exhibit A.<sup>1</sup>

3. On February 24 2011, I served, on counsel for ConnectPR, DigitalMojo's second set of discovery requests in the Opposition, including DigitalMojo's request for production (second set), and interrogatories (second set). On or about April 5, 2011, I received responses to DigitalMojo's second set of discovery request from ConnectPR. Those responses included over 2600 pages of documents.

4. Through the period of about June 1, 2011, through about July 31, 2011, I reviewed the 2600 pages of documents received from ConnectPR, and I reviewed ConnectPR's web site and other marketing materials in light of such discovery responses, and in light of ConnectPR's initial stated position regarding the legal effect of its registration. From these materials, I have come to the conclusion that ConnectPR is not using the Mark for some or all "marketing and market research and consulting services; public media relations services and sales promotion services," as set forth in this registration, either at the time of filing its application, or thereafter.<sup>2</sup>

5. Through the period of about July 31, 2011, to August 22, 2011, I discussed the implications of ConnectPR's position regarding its registration with DigitalMojo.

6. On August 22, prior to the discovery cutoff in the Opposition, I filed this Petition to cancel this registration of the Mark.

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<sup>1</sup> I attach the correspondence of opposing counsel here, consistent with FRE Rule 408, for the purpose of negating ConnectPR's contention of undue delay in filing DigitalMojo's Petition to Cancel Trademark Registration No. 2,373,504, and not to prove liability for, invalidity of, or amount of a claim.

<sup>2</sup> Pleading in the alternative in this Petition, DigitalMojo alleges that ConnectPR did not use the Mark for the services identified in this registration, or for some of such services, or for some part of such services.

7. On August 26, 2011, and for reasons of judicial economy since the scope of the services identified in ConnectPR's registration is an issue arising in this cancellation action and in the Opposition, I filed a motion to consolidate this Petition to cancel this registration for the Mark into the Opposition.

8. On September 4, 2011, I served on counsel for ConnectPR DigitalMojo's second set of DigitalMojo's request for admission (second set) in the Opposition. As DigitalMojo's position in the Opposition is, contrary to that of ConnectPR, that cm's "marketing" and "market research" and "consulting services" may not be related to ConnectPR's "marketing" and "market research" and "consulting services," the purpose of DigitalMojo's second set of requests for admissions is to define with more clarity and precision what services ConnectPR has provided under its Mark. As of the date of this Declaration, DigitalMojo has not received responses to its second set of requests for admissions.

I swear under penalty of perjury by the laws of the United States of America that the foregoing is true and correct to the best of my knowledge.

Date: October 17, 2011



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Thomas W. Cook, Reg. No. 38,849  
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DECLARATION OF THOMAS COOK, ESQ.  
IN SUPPORT OF PETITIONER'S RESPONSE  
TO DEFENDANT'S MOTION TO DISMISS - Rule 12(b)



CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this document is today being submitted via electronic filing utilizing the ESTTA system on:

Date: October 17, 2011



Thomas W. Cook

CERTIFICATE OF SERVICE

This is to certify that on this date, a true copy of the foregoing

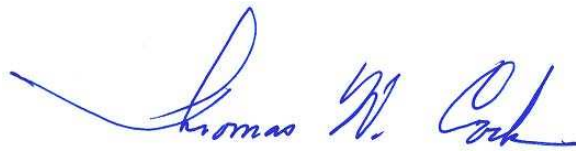
**DECLARATION OF THOMAS COOK, ESQ.  
IN SUPPORT OF PETITIONER'S RESPONSE  
TO DEFENDANT'S MOTION TO DISMISS - Rule 12(b)**

is being served, by U.S. mail, postage prepaid, to the attorney of the owner of record, of U.S.

Registration No. 2,373,504 at the following addresses:

Karl R. Cannon  
CLAYTON, HOWARTH & CANNON, P.C.  
P.O. Box 1909  
Sandy, Utah 84091-1909

Date: October 17, 2011



Thomas W. Cook

DECLARATION OF THOMAS COOK, ESQ.  
IN SUPPORT OF PETITIONER'S RESPONSE  
TO DEFENDANT'S MOTION TO DISMISS - Rule 12(b)

## EXHIBIT A

Grant R. Clayton  
Alan J. Howarth, Ph.D.  
Karl R. Cannon  
Terrence J. Edwards  
Brett J. Davis  
Kerry W. Brown  
Wesley M. Lang\*  
David N. Preece\*  
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*Registered Patent Attorneys*

*\*Of Counsel*

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---

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January 14, 2011

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VIA EMAIL TO: [tcook@thomascooklaw.com](mailto:tcook@thomascooklaw.com)  
Confirmation Via Facsimile To: 415-339-8555  
Confirmation Via First Class Mail

Mr. Thomas W. Cook  
Thomas Cook Intellectual Property Attorney  
P.O. Box 1989  
Sausalito, California 94966-1989

Re: U.S. Trademark Application No. 77/714,693 for "CONNECT" mark  
Our File No. T12092.A

Dear Mr. Cook:

This letter is in furtherance to the above-identified case, and also in response to the substantive issues raised in your email dated December 1, 2010. Our client is puzzled at your side's incongruent approach since last summer. Digitalmojo first proposed negotiating to amend the opposed filing, by eliminating goods and services which, when used with the mark "CONNECT," present a likelihood of confusion with our client's rights. When our side provided the requested list of services our client's marks are used with, your client refused to eliminate the corresponding services from its filing and, contrary to its own proposal last summer, refused to counter-propose a meaningful amendment. Instead, your side asked our side to prove ConnectPR is entitled to the scope of rights granted in its registrations, as if to imply that our client's trademark registrations are on trial. Your side also asserted that our client's registrations are "too broad," claiming the Office would never grant them today.

Your side, while amicable, offers assertions that contradict the facts and the law. The Trademark Office has for example allowed other filings this past year with recitations you claim would never be allowed today, but that are nearly identical to "Communications services, namely, delivery of messages by electronic transmission," the recitation granted in ConnectPR's registration no. 2,365,074. Your side also objects to "Marketing and market research and consulting services" as recited in ConnectPR's registration no. 2,366,850, purportedly for being too broad as well, and your side claims that its "CONNECT" filing reciting the very same services is not likely to be confused. Your side continues to imply ConnectPR's registrations are on trial, that the TTAB is likely to narrow their scope. Such positions are a distraction, because they contradict the facts, the law and current Trademark Office practice, while delaying real progress. Our client has decided that it is done negotiating, because your side has failed to propose any meaningful amendments and, strangely, refused a royalty-free license.

We have taken the time to carefully review the rest of Digitalmojo, Inc.'s positions as well. After careful consideration, it is clear that further settlement discussions will be fruitless. Digitalmojo must abandon certain notions, as explained below, that are inconsistent with established trademark law.

**I. The Scope of ConnectPR's Trademark Rights is Not Limited by Its "Actual" Use, and Digitalmojo is not Entitled to the Opposed "CONNECT" filing it has Declined to Meaningfully Amend**

ConnectPR's actual use is identical to what is recited in its registrations. Digitalmojo persists in its misplaced and inaccurate assertion that ConnectPR's use is not only less than what is recited in its registrations, but that ConnectPR's trademark rights can and will be limited by the TTAB to what its actual use is, and that Digitalmojo is therefore entitled to registration of the opposed filing that it has declined to meaningfully amend. This is simply incorrect, even if ConnectPR's actual use could be viewed as "less than" its registration recitations. It is well established that the scope of a trademark registration cannot be limited by the current business practices of the registrant.

Where likelihood of confusion is asserted by an opposer with respect to a trademark for which an application for registration has been filed, the issue must be resolved on the basis of not only a comparison of the involved marks, but also on consideration of the goods named in the application and in opposer's registration and, in the absence of specific limitations in the application and registration, on consideration of the normal and usual channels of trade and methods of distribution. The description of the goods in the application for registration is critical because any registration that issues will carry that description. **Moreover, although a registrant's current business practices may be quite narrow, they may change at any time from, for example, industrial sales to individual consumer sales.**

*CBS, Inc. V. Morrow*, 708 F.2d 1579, 1581, 218 USPQ 198, 199 (Fed. Cir. 1983) (citations omitted). As the Federal Circuit has further observed:

[T]he identification of goods/services statement in the registration, not the goods/services actually used by the registrant, frames the issue. . . . [T]he Board must look to the registration themselves to determine the scope of the goods covered . . . .

*Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 55 USPQ2d 1842 (Fed. Cir. 2000); *see also Canadian Imperial Bank of Commerce v. Wells Fargo Bank Nat'l Ass'n*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987) (courts look only to the goods or services recited in applicant's application vis-a-vis those in opposer's registration, regardless of actual usage of the parties).

Although Digitalmojo has repeatedly contended that it is entitled to a registration of the opposed "CONNECT" application, in part, for the purported reason that ConnectPR's registrations are overly

broad, there is no authority that supports Digitalmojo's assertion that the scope of the registrations can be narrowed based upon ConnectPR's "actual" use. In fact, as shown by the authority above, the exact opposite is true and ConnectPR is entitled to the broad scope of its registrations, even if its "actual" or "real" use were not as broad as is recited in the registrations. Of note, "[i]t is well-settled that the issue of likelihood of confusion must be determined on the basis of the goods as they are identified in the involved application and cited registration, **rather than on what any evidence may show as to the actual nature of the goods, their channels of trade and/or classes of purchasers.**" *In re Total Quality Group, Inc.*, 51 USPQ2d 1474 (TTAB 1999) (emphasis added). Digitalmojo cannot change the law, and it will not be able to persuade the TTAB to tamper with the above-cited well-settled precedent. Further, ConnectPR's actual use of the marks in the cited registrations is in fact broad, but it is also irrelevant. The main issue in the present opposition is whether Digitalmojo's goods and services, as defined in its application, are likely to cause confusion with Connect PR's mark in connection with the goods and services recited in ConnectPR's registrations. The answer is yes, and we look forward to the TTAB's decision, as we are confident it will be consistent with the law cited in this letter and thus favorable to ConnectPR's trademark rights.

ConnectPR is not willing to give up any of its rights. Even if there were significant differences between the scope of ConnectPR's "actual" use and the broad scope of the rights afforded by its registrations, ConnectPR would be unwilling to give up that scope and gift part of it to Digitalmojo. And yet, that is exactly what your side's proposals have asked us to do. This is contrary to what the law affords to registration owners.

ConnectPR will now proceed to assert the full extent of its rights, based upon the goods and services as recited in its registrations and not upon its "actual" use, as this is clearly ConnectPR's right under the trademark law. Digitalmojo's insistence on comparing what it "intends" to do with what ConnectPR is "actually" doing, is a diversionary tactic that is inconsistent with trademark law and is the reason for the breakdown of the settlement negotiations.

Based upon the above, ConnectPR will not participate in any further misplaced negotiations, because it is tired of wasting time. ConnectPR, for at least the above reasons, will not entertain any further the premise that extrinsic evidence can limit the scope of its registered marks. ConnectPR is confident that the TTAB will not choose to disregard well-settled law in favor of Digitalmojo's self-serving theories that contract the law. Further, since ConnectPR's registrations themselves do not restrict the actual nature of the services, the respective classes of customers, or the channels of trade, neither will ConnectPR do so for the purposes of furthering settlement negotiations.<sup>1</sup> ConnectPR is

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entitled to the full scope of its registrations. Digitalmojo may be able to convince itself to the contrary, but it will convince the TTAB. Thus, ConnectPR will not entertain any further discussions about its "actual" use of its registered marks in an attempt to limit its trademark rights. If Digitalmojo can agree on this principle and later desires to abandon all portions of its conflicting filing that are destined to be ruled un-registrable by the TTAB, I will pass it along to ConnectPR, who may or may not chose to re-engage in settlement discussions at the time, if such a point is ever reached.

## II. Response to Digitalmojo's Proposed Un-Meaningful Amendment to "CONNECT" Mark

Digitalmojo's proposed deletion of the words "Business marketing services in the nature of" from the class 35 section of the opposed application is insufficient to resolve this matter. Digitalmojo's proposed change would result in no effective change to the scope of the opposed filing. Even if you could convince us that the proposal would result in some small narrowing in some abstract sense, it would still fall far short of avoiding a likelihood of confusion. For example, the identification of the services of the "CONNECT" mark in class 35 would still include the following conflicting services, which would cause a severe likelihood of confusion:

- "agency representation of companies **marketing** a variety of services to home owners and renters, namely, utility hook-ups, telecommunication services, home security services, home warranties, home and yard maintenance, furniture and appliance rental"
- "comparative **marketing** and **advertising** services for providers of residential and business telecommunications services, namely, for providers of broadband cable, DSL, fiber-optic and satellite Internet access services, cable and satellite television, voice over IP, and long-distance telephone services; operation of telephone call centers for others"
- "**marketing** of high speed telephone, Internet, and wireless access, and directing consumers to access providers"
- "**advertising** and information distribution services, namely, providing classified advertising space via the global computer network"
- "**promoting** the goods and services of others over the Internet"

Without question, the above services are nothing more than a subset of the services in ConnectPR's class 35 registrations which include again, for example "Marketing and market research and consulting services; public and media relations services and sales promotion services" (ConnectPR's registration no. 2,366,850). In fact, the wording that would remain in the opposed "CONNECT" application, if our side were to naively agree to Digitalmojo's proposed amendment, still includes identical wording or

grammatically equivalent wording, as used in the ConnectPR class 35 registrations, namely the terms "marketing" and "promotion." Further, the services of "advertising" as recited in the "CONNECT" application are highly related, if not identical to, "marketing," "marketing research," and "sales promotion services" as used in the Connect PR class 35 registration. *See, e.g., In re Strategic Marketing Partners, Inc.*, No. 75/402,227 (TTAB 2000) (finding that advertising services and marketing services are highly related).

For the above reasons, ConnectPR cannot agree to Digitalmojo's proposed amendment. ConnectPR in fact finds Digitalmojo's proposed amendment disingenuous and insulting to ConnectPR's intelligence, because of the identical terms that remain and the likelihood of confusion that would remain, and the resulting harm to ConnectPR's trademark rights that would result, if ConnectPR were naive enough to agree to Digitalmojo's new proposal.

### **III. A Royalty-Free License is an Important Component to any Consent Agreement**

The following topic is now moot in view of ConnectPR's decision to terminate negotiations. However, we provide the following because you requested it, and we hereby honor that request.

As stated in McCarthy:

A consent agreement is neither an assignment nor a license. It is not an assignment because neither party is assigning any rights in their marks to the other. It is not a license because party A is not granting a right to use to Z in return for payment of royalties. In a license, the licensee is engaging in acts which would infringe the licensor's mark but for the permission granted in the license. In that event, quality control is essential. But in a consent, the consentee is permitted to engage in defined actions which do not infringe the consenter's mark, and the agreement implicitly or explicitly recognizes that. **If, in fact, party A "consents" to Z's usage which is an infringement, then it would be a "license" which requires quality control to be valid and not to result in possible abandonment or loss of priority.**

J. Thomas McCarthy, Trademarks and Unfair Competition § 18:79, (4th ed. 2010) (emphasis added) (citations omitted). Based upon the above, ConnectPR simply cannot consent to the infringement of its own marks by a third party through a consent agreement. If Digitalmojo were someday to realize its mistake and propose an acceptance of ConnectPR's now-withdrawn proposal for amending the "CONNECT" application and licensing the remaining portion to Digitalmojo, the licensed portion of that proposal would be required absent any persuasive and conclusive demonstration that the remaining goods/services are not likely to cause confusion with ConnectPR's trademark rights.

Mr. Thomas W. Cook  
Thomas Cook Intellectual Property Attorney  
January 14, 2011  
Page 6

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#### IV. Conclusion

We are confident that a likelihood of confusion will be found by the TTAB, as Digitalmojo's proposed services are nothing more than a subset of ConnectPR's broad services recited in its registrations. Since Digitalmojo has flatly rejected ConnectPR's previous cooperative proposal for an amendment and a license of some of the class 35 services recited in Digitalmojo's application, and has countered with an insulting amendment proposal that amounts to no substantive change of any kind, ConnectPR has no further interest in negotiating. ConnectPR shall now vigorously prosecute the opposition proceeding. You are being served with discovery requests, which you should receive on the same day you receive this letter.

It is our understanding that Digitalmojo has not initiated any use of the "CONNECT" mark. Please be advised that Digitalmojo risks an infringement suit if it begins using the "CONNECT" mark in a manner that violates ConnectPR's trademark rights.

Please be advised that any evasive or incomplete responses to our side's discovery requests will, after the rules pertaining to cooperation have been satisfied, be addressed with a motion to compel. We look forward to your complete responses to our discovery requests, within the time provided by the rules.

Sincerely,

CLAYTON, HOWARTH & CANNON, P.C.

  
Karl R. Cannon

KRC/BJD/jms

cc: Janeen Bullock, Managing Partner  
Connect Public Relations, Inc.



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of  
Trademark Registration No. 2,366,850  
Trademark: CONNECTPR  
Registered: July 11, 2000

DIGITALMOJO, INC.,  
Petitioner,

Cancellation No. 92054395

Registration No. 2,366,850

v.

CONNECT PUBLIC RELATIONS, INC.  
Respondent.

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**DECLARATION OF THOMAS COOK, ESQ.  
IN SUPPORT OF PETITIONER'S RESPONSE  
TO DEFENDANT'S MOTION TO DISMISS - Rule 12(b)**

I, Thomas W. Cook, Esq. declare as follows:

1. I am the attorney of record for Petitioner DIGITALMOJO, INC. ("DigitalMojo"). I have personal knowledge of the facts herein stated. I am prepared to testify in a court of law regarding such facts if requested.

2. On or about January 14, 2011, and in connection with settlement discussions, I received correspondence from Karl Cannon, attorney for Respondent CONNECT PUBLIC RELATIONS, INC. ("ConnectPR), relating to its opposition to DigitalMojo's application for registration of its mark CONNECT, opposition number 91196299 (the "Opposition"). In the Opposition, ConnectPR has asserted this registration 2,366,850 as one basis for opposition, claiming likelihood of confusion between ConnectPR's service mark CONNECTPR (the "Mark") and DigitalMojo's mark CONNECT. From such correspondence and communications, and from

discussions and correspondence leading to and after this correspondence, I began to understand ConnectPR's position regarding the scope and extent of ConnectPR's claim regarding the legal effect of its registration. I attach a true and correct copy of the Cannon letter of January 14, 2001 to this Declaration as Exhibit A.<sup>1</sup>

3. On February 24 2011, I served, on counsel for ConnectPR, DigitalMojo's second set of discovery requests in the Opposition, including DigitalMojo's request for production (second set), and interrogatories (second set). On or about April 5, 2011, I received responses to DigitalMojo's second set of discovery requests from ConnectPR. Those responses included over 2600 pages of documents.

4. Through the period of about June 1, 2011, through about July 31, 2011, I reviewed the 2600 pages of documents received from ConnectPR, and I reviewed ConnectPR's web site and other marketing materials in light of such discovery responses, and in light of ConnectPR's initial stated position regarding the legal effect of its registration. From these materials, I have come to the conclusion that ConnectPR is not using the Mark for some or all "marketing and market research and consulting services; public media relations services and sales promotion services," as set forth in this registration, either at the time of filing its application, or thereafter.<sup>2</sup>

5. Through the period of about July 31, 2011, to August 22, 2011, I discussed the implications of ConnectPR's position regarding its registration with DigitalMojo.

6. On August 22, prior to the discovery cutoff in the Opposition, I filed this Petition to cancel this registration of the Mark.

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<sup>1</sup> I attach the correspondence of opposing counsel here, consistent with FRE Rule 408, for the purpose of negating ConnectPR's contention of undue delay in filing DigitalMojo's Petition to Cancel Trademark Registration No. 2,366,850 (this action), and not to prove liability for, invalidity of, or amount of a claim.

<sup>2</sup> Pleading in the alternative in this Petition, DigitalMojo alleges that ConnectPR did not use the Mark for the services identified in this registration, or for some of such services, or for some part of such services.

7. On August 26, 2011, and for reasons of judicial economy since the scope of the services identified in ConnectPR's registration is an issue arising in this cancellation action and in the Opposition, I filed a motion to consolidate this Petition to cancel this registration for the Mark into the Opposition.

8. On September 4, 2011, I served on counsel for ConnectPR DigitalMojo's second set of DigitalMojo's request for admission (second set) in the Opposition. As DigitalMojo's position in the Opposition is, contrary to that of ConnectPR, that cm's "marketing" and "market research" and "consulting services" may not be related to ConnectPR's "marketing" and "market research" and "consulting services," the purpose of DigitalMojo's second set of requests for admissions is to define with more clarity and precision what services ConnectPR has provided under its Mark. As of the date of this Declaration, DigitalMojo has not received responses to its second set of requests for admissions.

I swear under penalty of perjury by the laws of the United States of America that the foregoing is true and correct to the best of my knowledge.

Date: October 17, 2011



---

Thomas W. Cook, Reg. No. 38,849  
Attorney for Applicant  
3030 Bridgeway, Suite 425-430  
Sausalito, California 94965  
Telephone: 415-339-8550

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this document is today being submitted via electronic filing utilizing  
the ESTTA system on:

Date: October 17, 2011



Thomas W. Cook

CERTIFICATE OF SERVICE

This is to certify that on this date, a true copy of the foregoing

**DECLARATION OF THOMAS COOK, ESQ.  
IN SUPPORT OF PETITIONER'S RESPONSE  
TO DEFENDANT'S MOTION TO DISMISS - Rule 12(b)**

is being served, by U.S. mail, postage prepaid, to the attorney of the owner of record, of U.S.

Registration No. 2,366,850 at the following addresses:

Karl R. Cannon  
CLAYTON, HOWARTH & CANNON, P.C.  
P.O. Box 1909  
Sandy, Utah 84091-1909

Date: October 17, 2011



Thomas W. Cook

DECLARATION OF THOMAS COOK, ESQ.  
IN SUPPORT OF PETITIONER'S RESPONSE  
TO DEFENDANT'S MOTION TO DISMISS - Rule 12(b)

## EXHIBIT A

Grant R. Clayton  
Alan J. Howarth, Ph.D.  
Karl R. Cannon  
Terrence J. Edwards  
Brett J. Davis  
Kerry W. Brown  
Wesley M. Lang\*  
David N. Preece\*  
Weili Cheng, Ph.D.\*

*Registered Patent Attorneys*  
*\*Of Counsel*

# CLAYTON HOWARTH & CANNON

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## ATTORNEYS AT LAW

January 14, 2011

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grammatically equivalent wording, as used in the ConnectPR class 35 registrations, namely the terms "marketing" and "promotion." Further, the services of "advertising" as recited in the "CONNECT" application are highly related, if not identical to, "marketing," "marketing research," and "sales promotion services" as used in the Connect PR class 35 registration. *See, e.g., In re Strategic Marketing Partners, Inc.*, No. 75/402,227 (TTAB 2000) (finding that advertising services and marketing services are highly related).

For the above reasons, ConnectPR cannot agree to Digitalmojo's proposed amendment. ConnectPR in fact finds Digitalmojo's proposed amendment disingenuous and insulting to ConnectPR's intelligence, because of the identical terms that remain and the likelihood of confusion that would remain, and the resulting harm to ConnectPR's trademark rights that would result, if ConnectPR were naive enough to agree to Digitalmojo's new proposal.

### **III. A Royalty-Free License is an Important Component to any Consent Agreement**

The following topic is now moot in view of ConnectPR's decision to terminate negotiations. However, we provide the following because you requested it, and we hereby honor that request.

As stated in McCarthy:

A consent agreement is neither an assignment nor a license. It is not an assignment because neither party is assigning any rights in their marks to the other. It is not a license because party A is not granting a right to use to Z in return for payment of royalties. In a license, the licensee is engaging in acts which would infringe the licensor's mark but for the permission granted in the license. In that event, quality control is essential. But in a consent, the consentee is permitted to engage in defined actions which do not infringe the consenter's mark, and the agreement implicitly or explicitly recognizes that. **If, in fact, party A "consents" to Z's usage which is an infringement, then it would be a "license" which requires quality control to be valid and not to result in possible abandonment or loss of priority.**

J. Thomas McCarthy, Trademarks and Unfair Competition § 18:79, (4th ed. 2010) (emphasis added) (citations omitted). Based upon the above, ConnectPR simply cannot consent to the infringement of its own marks by a third party through a consent agreement. If Digitalmojo were someday to realize its mistake and propose an acceptance of ConnectPR's now-withdrawn proposal for amending the "CONNECT" application and licensing the remaining portion to Digitalmojo, the licensed portion of that proposal would be required absent any persuasive and conclusive demonstration that the remaining goods/services are not likely to cause confusion with ConnectPR's trademark rights.

Mr. Thomas W. Cook  
Thomas Cook Intellectual Property Attorney  
January 14, 2011  
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#### IV. Conclusion

We are confident that a likelihood of confusion will be found by the TTAB, as Digitalmojo's proposed services are nothing more than a subset of ConnectPR's broad services recited in its registrations. Since Digitalmojo has flatly rejected ConnectPR's previous cooperative proposal for an amendment and a license of some of the class 35 services recited in Digitalmojo's application, and has countered with an insulting amendment proposal that amounts to no substantive change of any kind, ConnectPR has no further interest in negotiating. ConnectPR shall now vigorously prosecute the opposition proceeding. You are being served with discovery requests, which you should receive on the same day you receive this letter.

It is our understanding that Digitalmojo has not initiated any use of the "CONNECT" mark. Please be advised that Digitalmojo risks an infringement suit if it begins using the "CONNECT" mark in a manner that violates ConnectPR's trademark rights.

Please be advised that any evasive or incomplete responses to our side's discovery requests will, after the rules pertaining to cooperation have been satisfied, be addressed with a motion to compel. We look forward to your complete responses to our discovery requests, within the time provided by the rules.

Sincerely,

CLAYTON, HOWARTH & CANNON, P.C.

  
Karl R. Cannon

KRC/BJD/jms

cc: Janeen Bullock, Managing Partner  
Connect Public Relations, Inc.